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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,657	06/13/2007	Peter Jonathan Bentley	020884-000014	2391

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EXAMINER
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ROBINSON, CHANCEITY N

ART UNIT	PAPER NUMBER
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1722

MAIL DATE	DELIVERY MODE
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12/22/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/599,657

Applicant(s)

BENTLEY ET AL.

Examiner

CHANCEITY N. ROBINSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/20/2010 has been entered.
2. Claims 1-14 are currently pending.

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen (US 6,177,182 B1) in view of Bennett et al. (WO 02/11984 A1).

Regarding claims 1-4, 8 and 10-11, Nguyen discloses a thermally reactive infrared absorption polymer comprising an infrared absorption chromophoric moiety comprising derivatives including indole cyanine dye and benz[e]-indole cyanine dye, which is bonded to the backbone of an alkali-soluble phenolic resin. See column 3, line 40- column 5, line 14. Further, Nguyen discloses indole cyanine dye such as ADS810PO and benz[e]-indole cyanine dye such as ADS805PO, which meets the limitations of the instant claim of salts of indole cyanine dye and benz[e]-indole cyanine dye. (See examples 5 and 14). Nguyen discloses a heat sensitive positive working lithographic printing plate precursor comprising a substrate and a layer coated thereon, wherein the layer comprises the near infrared absorption polymer. See example 18 and claim 4. Also, Nguyen discloses a process of manufacture of a heat sensitive positive working lithographic printing plate precursor, said method comprising: a) imagewise exposing the printing plate precursor with a near-infrared laser emitting at between 780 and 850 nm (example 16); and b) developing the precursor in a developing solution to remove the exposed areas. See reference claims 11-12 and examples 23-24. Also, Nguyen discloses the drying the coated substrate coated at 80°C to give the plate precursor. See example 17.

Nguyen does not disclose the infrared chromophoric moiety is an indole cyanine dye combined with a benz[e]-indole cyanine dye. However, Bennett et al. disclose a near infrared absorption polymer (abstract and page 15, lines 1-31) comprising more than cyanine dyes (infrared radiation absorbing compounds, page 17, lines 1- page 18, line 5) that are covalently bonded to the polymer (page 9, lines 2-3). Bennett et al. teach that the infrared radiation absorbing compounds aids in providing improvement to sensitivity of the coating and its mechanical robustness. Therefore, it would have been obvious to one of ordinary skill in the art at the time of

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the invention to modify the near infrared absorption polymer of Nguyen to include one indole cyanine dye and also a benz[e]-indole cyanine dye because Bennett et al. teach the infrared radiation absorbing compounds aid in providing improvement to sensitivity of the coating.

Regarding claims 5-6 and 13, Nguyen does not explicitly disclose the number ratio of indole cyanine dye to benz[e]-indole cyanine dye is comprised in the range of 1:1 to 1:5. However, Nguyen recognizes that a mixture of two different cyanine dyes can be combined at different weight ratios. See example 16. Further, a person skilled in art would readily identify the number (molar) ratio of the cyanine dyes presented in the infrared absorption polymer as too large or too small would affect the stability of the coating substrate of the printing plate. The number ratio is therefore optimizable. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify/optimize the cyanine dyes to optimize ratio to acquire effective stability. Discovery of optimum value of result effective variable in known process is ordinarily within skill of art. In re Boesch, CCPA 1980, 617 F.2d 272, 205 USPQ215.

Regarding claims 7 and 14, Nguyen does not explicitly disclose the number ratio of the total pendent IR chromophoric moieties relative to the parent alkali-soluble resin is comprised in the range of 1:30 to 1:5 or 1:50 to 1:3. However, a person skilled in art would identify the number ratio of the total pendent IR chromophoric moieties relative to the parent alkali-soluble resin is too large or too small would affect the stability of the coating substrate of the printing plate. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify/optimize the total pendent IR chromophoric moieties relative to the parent alkali-soluble resin to optimize the amounts to acquire effective stability. Discovery of optimum

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value of result effective variable in known process is ordinarily within skill of art. In re Boesch, CCPA 1980, 617 F.2d 272, 205 USPQ215.

Regarding claim 9, Nguyen does not explicitly disclose a positive printing plate precursor, wherein the dry coat weight of the coating layer comprising the near infrared absorption polymer is in the range 1.4-1.9 g/m<sup>2</sup>. However, Nguyen discloses a dry coating weight of 2.0 g/m<sup>2</sup>. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that the dry coat weight of the coating layer is 2.0 g/m<sup>2</sup> (reference) and 1.9 g/m<sup>2</sup> (instant application) are closely related and therefore would be expected to perform in the same manner. The same results of the coating layer having a dry coat weight of 2.0 g/m<sup>2</sup> as would be expected from the coating layer having a dry coat weight of 1.9 g/m<sup>2</sup>. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (citing *In re Petering*, 301 F.2d 676, 682, 133 USPQ 275, 280 (CCPA 1962)) (MPEP 2131.03).

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen (US 6,177,182 B1) in view of Bennett et al. (WO 02/11984 A1) as applied to claims 1-11 and 13-15 are above, and further in view of Tao et al. (US 6,939,663 A1).

Regarding claim 12, Nguyen does not disclose the resin is a novolak resin. However, Tao et al. disclose a method for forming a positive working lithographic printing plate comprising a layer of an imageable coating over a substrate, wherein the imageable coating composition comprises of a novolak resin. See column 5, lines 36-52. Therefore, it would have been obvious to one of ordinary skill in the art to modify the resin of Nguyen as a novolak resin because Tao et al. disclose the novolak resins are thermoplastic commonly used in lithography and allows for on-press development.

### Response to Arguments

7. Applicant's arguments filed 09/03/2010 have been fully considered but they are not persuasive. Applicant's principal arguments are

Bennett does not cure the deficiencies of Nguyen. The modifying means of Bennett is disclosed to alter the dissolution rate of the composition in the developer. Specifically, the modifying means function by enhancing the dissolution of the polymer in the presence of heat or making the polymer more resistant to dissolution in unheated regions. The only compounds that are disclosed Bennett as being able to be covalently bonded to the hydroxyl group-containing polymer are the modifying means comprising functional groups Q or the modifying means comprising diazide moieties. Also, the dyes of Bennett et al. disclose when present, they are dissolved in the composition. No covalent bonding of the dyes to the hydroxyl group-containing polymer will occur. Bennett discloses *the "reversible insolubilizer compound" is not covalently bonded to the polymer and the compounds are either in a separate layer or admixed in the composition.* The present invention makes clear that the technical effect provided by the covalently bound chromophores is due to improved stabilization by steric hindrance and not a possible hydrogen bonding or complex formation as disclosed by Bennett. Consequently, the mechanisms of insolubilization are totally different. Also, one skilled in the art would not consider the advantages of Nguyen in view of Bennett.

A) Examiner respectfully disagrees. The examiner is not intermixing the teaching of Bennett. Bennett is only added to teach an infrared chromophoric moiety can be covalently bonded to a polymer. Bennett explicitly disclose a preferred composition for a positive-working printing plate modifying means effective to alter the dissolution rate of the composition in a

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developer, in unheated regions, in heated regions, or both in comparison with a corresponding composition not having such modifying means. The modifying means may be covalently bonded to the hydroxyl group-containing polymer. See page 5, lines 11-14 and lines 24-28. The polymer that the infrared chromophoric moiety is covalently bonded to is the hydroxyl group-containing polymer. Many dyes have a marked effect on the dissolution rate of the unheated coating in the developer, typically making it much more developer resistant. Thus a dye may be employed as a radiation absorbing compound and as a modifying means in certain coatings of the invention.

See page 16, lines 22-23. The invention may employ one or more radiation absorbing compounds and one or more reversible insolubilizer compounds. Certain compounds are available which perform both functions. Notable among these are the cyanine dyes, which are preferred herein as radiation absorbing compounds and/or reversible insolubilizer compounds.

See page 19, lines 1-5. Examiner agrees with the applicant that functional groups Q and/or diazide moieties are covalently bonded to the hydroxy group ; however, these functional groups and/or diazide moieties are reversible insolubilizer compounds. See pages 6, line 6 – page 4, line 11. The examiner notes the cyanine dyes of Bennett can either function as an absorber compound and/or a reversible insoluble compound. Therefore, examiner notes when the cyanine dye functions as a reversible insolubilizer compound it can be covalently bonded to the hydroxyl group-containing polymer as claimed by claim 1 of the instant application. Bennett teaches that infrared absorbing compounds aids in providing improvement to sensitivity of the coating and its mechanical robustness. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the near infrared absorption polymer of Nguyen to include one indole cyanine dye and also a benz[e]-indole cyanine dye because Bennett et al. teach the



infrared radiation absorbing compounds aid in providing improvement to sensitivity of the coating.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. improved stabilization by steric hindrance) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Instant Claim 1 only recites a near infrared absorption polymer comprising at least two different pendent infrared chromophoric moieties covalently bonded to the backbone of an alkali-soluble resin, wherein at least one of the pendent infra-red chromophoric moieties is an indole cyanine dye and the other of which is a benz[e]-indole cyanine dye. Also, applicants argue the functions of the cyanine dyes disclosed by Bennett and states that Bennett teaches away from the claimed invention. However, examiner notes applicant does not recite any limitation regarding the functionality of the infrared chromophoric moieties in the instant applications claimed invention.

Therefore, the rejection is maintained.

Applicant further argues Tao does not motivate, teach or suggest a near infrared absorption polymer comprising two different pendent infrared chromophoric moieties covalently bonded to the backbone of alkali-soluble resin. Tao is solely concerned with water soluble novolaks and their use in negative working and on-press developable plate precursor (therefore no alkaline development needed). Thus, the plate precursor of Tao is of a totally different technology to either Bennett or the present application. Accordingly, there is no reason for one

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skilled in the art considering the three cited references to go in the direction of applicants' invention.

Examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, Bennett et al., Nguyen and Jassen et al. all disclose a process to produce a printing plate as discussed above. Further, Tao is only added to disclose resin is a novolak resin. Examiner did not disclose adding Tao to teach a near infrared absorption polymer comprising two different pendent infrared chromophoric moieties covalently bonded to the backbone of alkali-soluble resin. Tao et al. disclose positive working printing plates are well-known in the art (column 1, lines 40-43). Tao et al. explicitly disclose an imageable layer comprising a novolak resin (column 5, lines 36-52), which is a thermoplastic commonly used in lithography. Therefore, the rejection is maintained.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHANCEITY N. ROBINSON whose telephone number is (571)270-3786. The examiner can normally be reached on Monday to Friday ( with every other Friday off): 9:00 am-6:00 pm eastern time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chanceity N Robinson/  
Examiner, Art Unit 1722

/Cynthia H Kelly/  
Supervisory Patent Examiner, Art Unit 1722